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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,472	06/25/2003	Theodore M. Boyd-Davis	BING-1-1003	3520

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EXAMINER

TALBOT, MICHAEL

ART UNIT PAPER NUMBER

3722

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,472

Applicant(s)

BOYL-DAVIS ET AL.

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-16, 22 and 24-35 is/are rejected.
- 7) ☒ Claim(s) 5-9, 17-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The numbering of claims is in improper form as claim 23 has been omitted. To preserve clarity within the record, claim 23 has been cancelled in lieu of renumbering the subsequent claims.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "opposing-force support assembly including a vacuum cup assembly" recited in claims 3,15 and 30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

2. The disclosure is objected to because of the following informalities:

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Refer to page 5, line 33, the character reference "second baseplate 170" should be changed to read --second baseplate 172--.

Refer to page 6, line 30, the character reference "second auxiliary rails 170" should be changed to read --second auxiliary rails 174--.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 6 and 18 are objected to because of the following informalities:

Claim 6, line 2, the phrase "adapted to mover the securing device" should be changed to read --adapted to move the securing device --.

Claim 18, line 2, the phrase "adapted to mover the securing device" should be changed to read --adapted to move the securing device --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3,15 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. How the opposing-force assembly and the vacuum cup assembly are connected and/or function together has not been clearly described or illustrated (Refer to the Drawing Objection).

### ***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,10-14,22,24-29 and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams '436. Adams '436 shows in Figures 1-5b an apparatus comprising a track assembly (11) adapted to the workpiece (14) via fasteners (28) and mounting steps (25) and vacuum pads (29), a carriage (15) including a tool support (62 in Fig. 17) adapted to receive a manufacturing drill tool (17) moveably (col. 3, lines 20-27) coupled to the track assembly and moveable relative to the translational axis (x-axis) and an opposing-force support assembly (22) coupled to the carriage and adapted to be secured to the workpiece to at least partially counterbalance a manufacturing force exerted on the workpiece by the manufacturing tool (col. 3, lines 20-37). Adams '436 shows the opposing-force support assembly including a clamp-up pin (23) adapted to engage a hole (13) in the workpiece and a clamp-up actuator (102) adapted to actuate the clamp-up pin into secure engagement with the workpiece. Adams '436 shows the track assembly including one rail (11) and the carriage is rollably (34,35) coupled to the rail (col. 3, line 71 through col. 4, line 9) in the translation direction (x-axis) and along the y-axis through slot (at 59,128). Adams '436 shows the carriage including a drive assembly (144,145,147) having a drive motor (144) operatively engaging the track and adapted to drive the carriage along the track (col. 7, line 73 through col. 8, line 38).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,16 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams '436 in view of Alam et al. 2004/0076484. Adams '436 lacks the opposing-force support assembly including a threaded pin adapted to threadedly engage a threaded hole in the workpiece. Alam et al. 2004/0076484 shows a thread adjustable member (14) operably in contact with a curved workpiece (18) prior to performing a drill operation. In view of this teaching of Alam et al. 2004/0076484, it would have been obvious to replace the clamp-up pin of Adams '436 with the threaded construction of Alam et al. 2004/0076484 to provide a more secure connection between the apparatus and workpiece thus increasing the stabilization of the manufacturing operation resulting in quicker, more precise drilling holes.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

***Allowable Subject Matter***

7. Claims 5-9 and 17-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3,15 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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8. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300.

This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot  
Examiner  
Art Unit 3722  
18 August 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER